



03-15-06

AF\$
JFW

"EXPRESS MAIL" MAILING LABEL
NUMBER EV821918501US

DATE OF DEPOSIT March 13, 2006
I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING DEPOSITED
WITH THE UNITED STATES POSTAL SERVICE "EXPRESS MAIL POST
OFFICE TO ADDRESSEE" SERVICE UNDER 37 C.F.R. 1.10 ON THE DATE
INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER FOR
PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

Lisa M. Snyder
(TYPED NAME OF PERSON MAILING PAPER OR FEE)
Lisa M. Snyder
(SIGNATURE OF PERSON MAILING PAPER OR FEE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of)
Marcia Grossman Nozik et al.) Group Art Unit: 3739
Title: SLING HOLDER) Examiner: A. Roane
Serial No.: 10/759,713) Confirmation No. 3259
Filed On: January 16, 2004) (Docket No.: 6881-0001-1)

Middletown, Connecticut, March 13, 2006

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This is an appeal to the Board of Appeals from an Office Action mailed October 13, 2005, marked "final" and the subsequent Advisory Action mailed January 30, 2006, in which the Examiner finally rejected claims 1-22 of the above-identified application. Appellant timely filed a Notice of Appeal at the U.S. Patent and Trademark Office on January 12, 2006. Therefore, the due date for filing the Appeal Brief is March 12, 2006. This brief is being filed in support of that Notice of Appeal.

One copy of this brief is being filed.

03/16/2006 DENMANU1 00000012 10759713

01 FC:2402

250.00 OP

I. REAL PARTY IN INTEREST

The real party in interest in this Appeal is Marcia Grossman Nozik et al.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interference proceedings known to Appellant or Appellant's legal representatives that would directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in this Appeal.

III. STATUS OF CLAIMS

Claims 1-22 are pending. Claims 1-22 have been finally rejected.

IV. STATUS OF AMENDMENTS

No amendments have been proposed in response to the final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed in one aspect to a sling holder (page 3, line 19) for holding an object for an extended period of time against the skin. The sling holder comprises a strap having a first end and an opposing second end; a single fastener for coupling the first end to the second end; and at least one pocket attachable to the strap. (Page 3, lines 19-23.) The fastener is positioned at the first end and the opposing second end of the strap and is positioned completely within the perimeter of the strap. (Page 4, lines 1-9, Figure 1.)

The present invention is directed in a second aspect to a sling holder (page 6, line 5) for holding an object against the skin. The sling holder comprises a first strap; a second strap (page 6, lines 6-9) for adjusting a length of the sling holder (page 6, lines 28-29); a single fastener for coupling a second end of the second strap to the first strap (page 6, lines 16-17); and at least one pocket attachable to at least one of the first strap and the second strap (page 6, lines 10-12). The second strap is attachable at a first end thereof to the first strap. (Page 6, lines 16-17.) The fastener is positioned at the first strap and the second end of the second

strap and is positioned completely within the perimeter of the first and second straps.
(Figures 7-9.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-10 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,440,159 to Edwards et al. (hereinafter “Edwards”).

B. Claims 1-10 and 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,823,984 to Silverberg (hereinafter “Silverberg”) in view of U.S. Patent No. 5,507,794 to Allen (hereinafter “Allen”). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Silverberg in view of Allen, as applied to claim 1, and further in view of U.S. Patent No. 5,069,208 to Noppel et al. (hereinafter “Noppel”).

C. Claims 16-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Silverberg in view of Allen.

VII. ARGUMENT

A. Claims 1-10 are patentable within the meaning of 35 U.S.C. §102(e).

The Examiner’s rejection of claims 1-10 under 35 U.S.C. §102(e) as allegedly being anticipated by Edwards is improper.

As noted above, the invention as recited in claim 1 is directed to a sling holder for holding an object for an extended period of time against the skin. The sling holder comprises a strap having a first end and an opposing second end; a single fastener for coupling the first end to the second end; and at least one pocket attachable to the strap. The fastener is positioned at the first end and the opposing second end of the strap and is positioned completely within the perimeter of the strap.

Edwards is directed to a wrap for applying thermal therapy to a patient. The wrap has a therapy section 12 and an outer pocket material 50 which together form a pocket 14 for holding a thermal unit 16. The wrap has upper 18A and 18B and lower 26A and 26B

opposing sides, wherein the upper sides have attaching elements 64 and 66 attached thereto and the lower sides have attaching elements 120 and 122 attached thereto. The user may therefore attach the upper opposing sides 18A and 18B together or attach the lower opposing sides 26A and 26B together to hold the wrap in place. Edwards also discloses a strap 11B wherein the strap has opposing ends 130 and 132 provided with attaching elements thereon. The strap functions to further hold the wrap in place by wrapping the strap about the wrap and connecting the opposing ends 130 and 132 together. The strap may also extend between the upper opposing sides 18A and 18B or the lower opposing sides 26A and 26B, to hold the wrap in place.

Edwards fails to disclose, teach, or suggest a strap having a first end and an opposing second end, a single fastener for coupling said first end to said second end, and at least one pocket attachable to said strap. The Edwards device has two fasteners, each of which are positioned on the respectively attachable “ears” of an hourglass-shaped wrap. Both sets of “ears” need to be attached (either directly or via a strap) or at least secured relative to each other for the Edwards device to properly operate. Thus, the two sets of “ears” define two fasteners and not a single fastener, as Appellant claims.

Accordingly, because Edwards fails to disclose, teach, or suggest a strap having a single fastener, as recited in claim 1, Edwards fails to anticipate claim 1. For at least this reason, claim 1 is allowable, and Appellant respectfully requests that the Examiner withdraw the rejection of claim 1.

Because claims 2-10 depend from claim 1, claims 2-10 add recitations that further define the subject matter of independent claim 1. Because claim 1 is believed to be allowable for at least the reason presented above, claims 2-10 are therefore also believed to be allowable. Consequently, Appellant respectfully requests that the rejections of claims 2-10 be withdrawn.

B. Claims 1-15 are patentable within the meaning of 35 U.S.C. §103(a).

The Examiner’s rejection of claims 1-10 and 12-15 under 35 U.S.C. §103(a) as allegedly being obvious over Silverberg in view of Allen is improper.

The recitations of claim 1 are presented above.

Silverberg is directed to an expandable wrap including one or more panels with the entire interior and/or exterior surfaces of fabric loop type material. The panel includes three

fasteners stitched to or removably attached to an edge of the panel. Each of the fasteners includes a surface having hook type fasteners fastened to the loop type fabric on the inner or outer surface of an adjoining panel edge. The fasteners extend over the edge of the panel for securing two adjoining panels. The wrap includes a pocket for holding thermo packs or weights. The pocket includes a lower flap and an upper flap, with the upper flap extending over the lower flap thereby forming a pocket. An outer surface of the pocket is preferably constructed of vinyl and includes hook type fasteners for securing the pocket to the loop type interior surface of the wrap. The wrap can be made to snugly and securely fit around a specific body part *without the need for elastic bands* (emphasis added). (Silverberg reference, column 2, lines 57-59.)

Allen is directed to a pliable support garment that conforms to the contours of different sized female breasts to provide heat or cold to reduce swelling and irritation in adjacent breast regions. The garment is an elongated support member having two ends and an adjustable securing member extending from one end for removably securing the support member ends. A pouch is disposed on the support member, and a temperature regulator is positioned therein for imparting a predetermined temperature to an area adjacent the pouch when the garment is worn about the torso. The garment may include a plurality of removable pouches and positioning means for positioning the pouches on the support member. The pliability of the support member derives from *a soft, flexible, elastic material that is capable of stretching in multiple directions* (emphasis added). (Allen reference, column 2, lines 65-67.)

Silverberg and Allen, individually or in combination, fail to disclose, teach, or suggest a sling holder having a strap having a single fastener, the fastener being positioned completely within the perimeter of the strap, as recited in claim 1. The fasteners in the Silverberg wrap extend over the edges of the panels. Fasteners that extend over the edges of panels are not within the perimeters of the panels. The adjustable securing member in the Allen device extends from one end of the support member. A securing member that extends from one end of a support member is likewise not within the perimeter of the support member (panel). The combination of a fastener that extends over the edges of a panel (as in Silverberg) and a securing member that extends from one end of a support member (as in Allen) also does not result in a fastener positioned within a perimeter of a strap, as recited in claim 1.

Furthermore, the Silverberg and Allen references teach away from each other and do not disclose, teach, or fairly suggest the invention as claimed. In particular, the Allen

reference emphasizes the stretchable, elastic qualities of its device while Silverberg explicitly discloses a wrap that snugly fits around a body area without the need for elastic bands. Thus, one of skill in the art would not likely look from multiple panel wraps that explicitly avoid the use of elastic bands (Silverberg) to stretchable elastic devices (Allen) to arrive at the invention as recited in claim 1.

Because neither Silverberg nor Allen, individually or in combination, disclose, teach, or suggest all the elements recited in claim 1, a prima facie case of obviousness has not been made by the Examiner. Furthermore, because Allen teaches away from Silverberg, Silverberg and Allen are not properly combinable and still further fail to provide a basis for a prima facie case of obviousness to disclose, teach, or suggest the sling holder as recited in claim 1. Accordingly, Appellant respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2-10 and 12-15 depend from claim 1, which is asserted to be non-obvious for the reasons presented above. Thus, claims 2-10 and 12-15 are themselves necessarily non-obvious. Appellant, therefore, respectfully requests that the rejections of claims 2-10 and 12-15 be withdrawn.

The Examiner's rejection of claim 11 under 35 U.S.C. §103(a) as allegedly being obvious over Silverberg in view of Allen is improper and further in view of Noppel is also improper.

Claim 11 also depends from claim 1, which is asserted to be non-obvious for the reasons presented above. Thus, claim 11 is likewise necessarily non-obvious. Appellant, therefore, respectfully requests that the rejection of claim 11 be withdrawn.

C. Claims 16-22 are patentable within the meaning of 35 U.S.C. §103(a).

The Examiner's rejection of claims 16-22 under 35 U.S.C. §103(a) as allegedly being obvious over Silverberg in view of Allen is improper.

The invention as defined by claim 16 is directed to a sling holder for holding an object against the skin. The sling holder comprises a first strap; a second strap for adjusting a length of the sling holder; a single fastener for coupling a second end of the second strap to the first strap; and at least one pocket attachable to at least one of the first strap and the second strap. The second strap is attachable at a first end thereof to the first strap. The fastener is

positioned at the first strap and the second end of the second strap and is positioned completely within the perimeter of the first and second straps.

The teachings of Silverberg and Allen are presented above.

Silverberg and Allen, individually or in combination, fail to disclose, teach, or suggest a sling holder having a first strap, a second strap, and a single fastener, the fastener being positioned at the first strap and the second end of the second strap and completely within the perimeter of the straps, as recited in claim 16. The fasteners in the Silverberg wrap extend over the edges of the panels. Fasteners that extend over the edges of panels are not within the perimeters of the panels. The adjustable securing member in the Allen device extends from one end of the support member. A securing member that extends from one end of a support member is likewise not within the perimeter of the support member (panel). The combination of a fastener that extends over the edges of a panel (as in Silverberg) and a securing member that extends from one end of a support member (as in Allen) also does not result in a fastener positioned within a perimeter of first and second straps, as recited in claim 16. Accordingly, because neither Silverberg nor Allen teach at least the fasteners being within the perimeters of straps, as recited in claim 16, neither Silverberg nor Allen, individually or in combination, teach all the elements recited in claim 16.

Furthermore, for the reasons presented above, Allen teaches away from Silverberg.

Because neither Silverberg nor Allen, individually or in combination, disclose, teach, or suggest all the elements recited in claim 16, a prima facie case of obviousness has not been made. Furthermore, because Allen teaches away from Silverberg, Silverberg and Allen are not properly combinable and still further fail to provide a basis for a prima facie case of obviousness to disclose, teach, or suggest the sling holder as recited in claim 16. Accordingly, Appellant respectfully requests that the rejection of claim 16 be withdrawn.

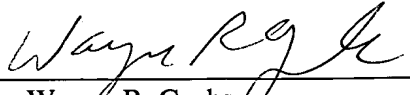
Claims 17-22 depend from claim 16, which is asserted to be non-obvious for the reasons presented above. Thus, claims 17-22 are themselves necessarily non-obvious. Appellant, therefore, respectfully requests that the rejections of claims 17-22 be withdrawn.

D. Conclusion

For the reasons discussed above, this application is in a condition for allowance and thus reversal of the outstanding rejections and allowance of the application is appropriate.

A check in the amount of \$250.00 is included with the submission of this Appeal Brief. If additional charges are incurred with respect to this Appeal Brief, they may be charged to Deposit Account No. 503342 maintained by Appellant's attorneys.

Respectfully submitted,

By: 
Wayne R. Grohs
Registration No. 48,945
Attorney for Appellant

Michaud-Duffy Group LLP
306 Industrial Park Road, Suite 206
Middletown, CT 06457-1532
Tel: (860) 632-7200
Fax: (860) 632-8269

VIII. CLAIMS APPENDIX

1. A sling holder for holding an object for an extended period of time against the skin, said sling holder comprising:
 - a strap having a first end and an opposing second end;
 - a single fastener for coupling said first end to said second end, said fastener being positioned at said first end and said opposing second end of said strap and positioned completely within the perimeter of said strap; and
 - at least one pocket attachable to said strap.
2. The sling holder of claim 1, further comprising a contoured section of varying width over a portion of a length of said strap.
3. The sling holder of claim 1, wherein said fastener is selectively fastenable to allow a length of said sling holder to be adjusted.
4. The sling holder of claim 1, wherein said fastener is hook-and-loop fastening material.
5. The sling holder of claim 1, wherein said strap is fabricated from a non-elastic material.
6. The sling holder of claim 1, further comprising padding disposed on said strap.
7. The sling holder of claim 1, wherein said pocket is removably attachable to said strap.
8. The sling holder of claim 1, wherein said pocket has an inwardly facing surface to be held against the skin of a user upon assembly of said sling holder on a body part.
9. The sling holder of claim 8, wherein said inwardly facing surface is fabricated from a thermally conducting material.
10. The sling holder of claim 8, wherein said inwardly facing surface is fabricated from a thermally insulating material.

11. The sling holder of claim 1, further comprising a temperature indicator on at least one of said strap and said pocket.
12. The sling holder of claim 1, further comprising a plurality of pockets to be attachable to said strap.
13. The sling holder of claim 1, wherein said strap includes an extension member interposed between ends of said strap for varying the length of said strap.
14. The sling holder of claim 13, wherein said extension member comprises a temporary fastener mounted on interfacially engaging portions of said strap.
15. The sling holder of claim 14, wherein said temporary fastener comprises a hook-and-loop fastening material.
16. A sling holder for holding an object against the skin, said sling holder comprising:
 - a first strap;
 - a second strap for adjusting a length of said sling holder, said second strap being attachable at a first end thereof to said first strap;
 - a single fastener for coupling a second end of said second strap to said first strap, said fastener being positioned at said first strap and said second end of said second strap and positioned completely within the perimeter of said first and second straps; and
 - at least one pocket attachable to at least one of said first strap and said second strap.

17. The sling holder of claim 16, further comprising a third strap interposable between said first strap and said second strap for further adjusting said length of said sling holder.
18. The sling holder of claim 17, wherein said third strap is removably coupled to each of said first strap and said second strap using a hook-and-loop material.
19. The sling holder of claim 16, wherein said fastener for coupling said first strap to said second strap at opposing ends thereof is a hook-and-loop material.
20. The sling holder of claim 17, wherein at least one of said first strap, said second strap and said third strap comprises a contoured section of varying width over a portion of a length thereof that facilitates the positioning of said strap on a body portion.
21. The sling holder of claim 17, further comprising padding disposed on at least one of said first strap, said second strap, and said third strap.
22. The sling holder of claim 16, wherein said pocket is removably attachable to at least one of said first strap and said second strap using a hook-and-loop fastening material.

IX. EVIDENCE APPENDIX

No evidence is submitted with this Appeal Brief.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are known to Appellant or Appellant's legal representatives.